



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,025	09/01/2000	Mark L. Yoseloff	PA0463.ap.US	5837

7590

09/10/2003

Mark A Litman & Associates P A  
3209 West 76th Street  
York Business Center  
Suite 205  
Edina, MN 55435

EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 09/10/2003

124

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/654,025

Applicant(s)

YOSELOFF ET AL.

Examiner

Carmen D. White

Art Unit

3714

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-21 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3714

***Withdrawal of Finality***

In view of the Appeal Brief filed on June 13, 2003, PROSECUTION IS HEREBY REOPENED. The new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 12-18 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by ***O'Halloran*** (6,439,993).

Regarding claims 1-9 and 20-21, O'Halloran teaches a method and apparatus of playing a video wagering game that comprises a player placing a wager on a reel-slot-

Art Unit: 3714

type video game event having a plurality of symbol positions; displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position; upon the occurrence of a predetermined triggering event, randomly selecting between zero and fewer than a maximum number of viewable symbol positions as a wild symbol position (col. 3, lines 37-44 teaches that the number of expanding wild card symbols can be in the range of 1 to  $n-1$  where  $n$  is the number of reels- this has been interpreted as meeting the instant limitation of between zero and fewer than a maximum number of viewable symbol positions); converting each symbol displayed within each selected wild symbol position to a wild symbol; and determining game outcomes based on the displayed game symbols and wild symbols in a single game event (col. 2, lines 54-67 and col. 3, lines 13-16).

Regarding claims 12-18, O'Halloran teaches all the limitations of the claim as discussed above. Further, col. 3, lines 37-44, see above, meets the instant claim limitation of randomly selecting at least one, and fewer than all symbol positions as wild symbol positions. Also, column 3, lines 20-27 teaches the features of claims 16-18.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***O'Halloran***.

Art Unit: 3714

Regarding claim 19, O'Halloran teaches all the limitations of the claim as discussed above. O'Halloran is silent regarding the explicit teaching of the maximum number of viewable positions being 15. However, O'Halloran is capable of performing this function. It is merely a matter of programming the equation disclosed in col. 3, lines 37-44 to set the maximum to 15. This would assist the gaming establishment in regulating wins/payouts; thereby preventing too great of a loss to the gaming establishment.

Regarding claim 10, O'Halloran teaches all the limitations of the claim as discussed above. O'Halloran is silent regarding the explicit teaching of the triggering symbol comprising a symbol on both a first and fifth reels. However, O'Halloran teaches that the symbol can appear in various reel positions. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in O'Halloran in order to make it easier to predict various winning outcomes by the gaming authority.

***Allowable Subject Matter***

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: O'Halloran as well as the other prior art references of record lack teaching the feature of the "symbol positions bearing game symbols that produce scatter pays are excluded from the random selection of wild symbol positions".

Art Unit: 3714

**Examiner's Response**

Applicant's arguments, see paper #13 filed 6/13/03, with respect to the rejection(s) of claim(s) 1-21 under Final Rejection have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of O'Halloran.

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

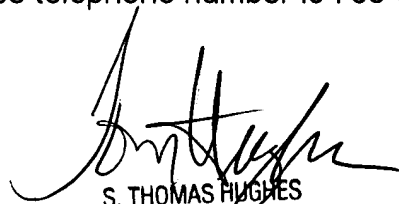
**USPTO Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding are assigned is (703) 305-3579 (Official communications) and 703-746-3244 or 703-308-7768 (Unofficial communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

  
cdw

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700  
*New grounds approved.*